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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,706	03/05/2002	Ione A. Kourides	25605-2BA/JPW/AJM/DRM	7959
7590	05/11/2004		EXAMINER	
John P. White Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036			GUZO, DAVID	
			ART UNIT	PAPER NUMBER
			1636	

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, drawn to DNA encoding the beta subunit of human thyroid stimulating hormone, plasmids containing said DNA and cells containing said DNA, classified in class 536, subclass 23.1.
- II. Claims 15-19, drawn to human thyroid stimulating hormone and a method of determining the cause of thyroid gland failure, classified in class 540, subclass 350.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions involve DNA (Group I) vs. protein (Group II) wherein DNA is biochemically, structurally and functionally distinct from the protein with each molecule being capable of supporting a separate patent. The plasmids and cells containing the DNA are likewise patentably distinct from the substantially pure human thyroid stimulating hormone of Group II. Each is classified differently and a search of one would not be coextensive with a search of the other and would be burdensome. The method of Group II does not require the particulars of the DNA of Group I and is to be practiced with human thyroid stimulating hormone protein, not just the beta subunit of the hormone.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was made to Alan J. Morrison on 4/30/04 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Guzo, Ph.D., whose telephone number is (571) 272-0767. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel, Ph.D., can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Guzo
May 3, 2004


DAVID GUZO
PRIMARY EXAMINER